

REMARKS

The Office Action dated June 21, 2011, has been reviewed, and the comments of the U.S. Patent Office have been considered. Claims 13-18 and 20-23 are presently pending in the instant application. Reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

Claims 13-14, 16-18, and 20-23 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Martensson (U.S. Patent No. 6,146,252) in view of Piacente *et al.* (U.S. Patent No. 5,858,160, hereinafter, "Piacente"). Martensson and Piacente, however, fail to render the claimed invention unpatentable. Each of the claims recite a specific combination of features that distinguishes the claims over from the prior art in different ways. For example, independent claim 13 recites a combination that includes, among other things:

"[a] laminated floor board comprising at least one cellulose sheet impregnated with a resin that is mechanically pressed and cut into a product, said product having a fiberboard core, wherein the product includes a surface, the product having both a perimeter area having an edge contour and an interior region, wherein the perimeter area is relieved such that a portion of the edge contour is below the interior region, wherein the interior region has a surface texture that varies in accordance with a visual pattern printed on the at least one cellulose sheet, wherein the visual pattern imitates another product."

Independent claim 17 recites yet another combination that includes, *inter alia*,

"[a] laminated product that has been mechanically pressed and cut to form individual units thereof, each individual unit including a surface having an interior region and an edge contour region, wherein at least a portion of the edge contour region has been pressed below the interior region, wherein the interior region has a surface texture that varies in accordance with a visual pattern printed on the at least one cellulose sheet, wherein the visual pattern imitates another product."

Independent claim 21 recites a further combination that includes, for instance,

"[a] laminated product unit, comprising . . . a cellulose core including a plurality of cellulose sheets, said cellulose sheets including at least one resin-impregnated cellulose sheet having a printed design . . . depressed deformities extending from an upper surface of said cellulose core, said depressed deformities

corresponding with the printed design . . . a perimeter rim including at least one depressed edge region.”

At the very least, the applied references, whether taken alone or in combination, fail to disclose or suggest any of these exemplary features recited in independent claims 13, 17, and 21.

The Examiner has failed to establish a *prima facie* case of obviousness for at least four reasons. First, the Examiner has not demonstrated how Martensson and Piacente, whether taken alone or in combination, disclose or suggest each and every feature recited in the claims. *See* M.P.E.P. § 2143 (8th ed. 2007). Second, the Examiner has not shown the existence of any reasonable probability of success in modifying Martensson, the base reference, based on the teachings of Piacente, the secondary reference, in a manner that could somehow result in the claimed invention. *See id.* Third, the Examiner has not identified any suggestion or motivation, either in the teachings of the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Martensson in a manner that could somehow result in the claimed invention. *See id.* Finally, the Examiner has not explained how his obviousness rationale could be found in the prior art — rather than being a hindsight reconstruction of Applicants' own disclosure. *See id.*

Each of the Examiner's factual conclusions must be supported by “substantial evidence” in the documentary record, as required by the Federal Circuit. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness “less the ‘haze of so-called expertise’ acquire insulation from accountability.” *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103. In this case, however, the Examiner has failed to satisfy his burden of demonstrating how Martensson, taken alone or in combination with Piacente, can either anticipate or render obvious each and every one of the limitations present in independent claims 13, 17 and 21 as required by the M.P.E.P. and Federal Circuit jurisprudence.

On page 4 of the Office Action, the Examiner readily admits that “*Martensson does not disclose the laminated material to have a surface texture that varies in accordance with the visual pattern that imitates another product.*” This fact has been previously addressed by

Applicant in, at least, the arguments submitted in the previous response filed June 8, 2011. In the aforementioned arguments, Applicant points out that the Examiner turns to the disclosure of Piacente in an attempt to remedy the deficiencies of Martensson. However, the Examiner cites two separate sections of Piacente – col. 3, lines 26-28 and col. 1, lines 53-57. It is expressly noted (emphasis added) that neither cited passage actually refers to teaches or suggests, *inter alia*, “a surface texture that varies in accordance with a visual pattern printed on the at least one cellulose sheet, wherein the visual pattern imitates another product” even if these cited passages are read together, as the Office Action appears to do. Reading these passages as modifying each other is improper (emphasis added) at least because col. 3, lines 26-28, refers to the “present invention,” while col. 1, lines 53-57 refers to “common practice.” These teachings cannot be properly combined, especially since the patent itself disparages the “common practice” in favor of the “present invention.” Regardless, there still is no teaching of a surface texture that varies in accordance with a visual pattern printed on the at least one cellulose sheet, *e.g.*, the texture of the exterior face that is compatible with an observable design.

The U.S. Patent and Trademark Office, the Court of Appeals for the Federal Circuit and the Supreme Court have all made clear the steps that the Patent Office must take to present a *prima facie* case of obviousness. That is, in its decision in *KSR v. Teleflex*, the Supreme Court reiterated that the Patent Office must follow the inquiry presented in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966): determine scope and content of prior art, determine the difference between the claimed invention and the prior art, and determine the level of ordinary skill in the art. See, *id.*

The Federal Circuit recently reiterated that “the patent examiner is responsible for marshalling the references whose teachings are most relevant to the claimed invention, and evaluating these teachings from the viewpoint of a person of ordinary skill in the field of the invention.” *In re Vaidyanathan*, 2010 WL 2000682 (Fed. Cir. May 19, 2010) (unpublished).

On September 1, 2010, the Patent Office issued “Examination Guideline Update: Developments in Obviousness Inquiry After *KSR v. Teleflex*” Federal Register, Vol. 75, No. 169, 53643-59 (Sept. 1, 2010). In the Examination Guideline Update, the Patent Office stated “It remains Office policy that appropriate factual findings are required in order to apply

the enumerated rationales [set forth in KSR] properly. If a rejection has been made that omits one of the required factual findings, and in response to the rejection a practitioner or inventor points out the omission, Office personnel must either withdraw the rejection, or repeat the rejection including all required factual findings.” *Id.* at 53645. The Patent Office goes on to counsel Office personnel “Simply stating [a] principle . . . without providing an explanation of its applicability to the facts of the case at hand is generally not sufficient to establish a *prima facie* case of obviousness.” *Id.* “The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” M.P.E.P. ¶ 706.

The Federal Circuit has stated “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Accordingly, “the Patent Office has the initial duty of supplying the factual basis for its rejection. It may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

At a first level of the inquiry, the Office Action has failed to make a showing that all of the elements were known or taught in the prior art (emphasis added). That is, the claimed structure of the laminated material to have a surface texture that varies in accordance with the visual pattern that imitates another product has not been shown, and thus cannot have been shown to be obvious. This omission alone should necessitate withdrawal of the rejection of claims 13, 17 and 21.

As per the guidance of the Supreme Court, the Federal Circuit, and the Patent Office itself, the inquiry forming the basis for a *prima facie* case of obviousness should next turn to whether one of skill would have had a reason to combine/modify the prior art to achieve the claimed invention; and whether there was a reasonable expectation of success to combine/modify the prior art. This failure to address the inquiries set forth in *KSR* clearly indicates that the Office has failed to make a *prima facie* case of obviousness.

Moreover, failure of the Office to provide adequate reasoning for the Applicants to provide a meaningful response leads to a finding of non-obviousness. *See In re Vaidyanathan*.

An Examiner “should not rely on conclusory statements that a particular feature would have been obvious or well known.” *Id.* at 17. “The examiner should at least explain the logic or common sense that leads the examiner to believe the claim would have been obvious. Anything less than this results in a record that is insulated from meaningful appellate review.” *Id.* at 18 (citing *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001)). The Federal Circuit also reiterated, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). As discussed above, the Examiner provides no articulated reasoning as to why one of ordinary skill would be motivated by Martensson to turn to the disclosure of Piacente. This lack of reasoning alone should necessitate withdrawal of the rejection.

On page 3, of the current Office Action, the Examiner states “[i] response to applicant’s argument that Martensson and Piacente are nonanalogous is not persuasive. Martensson and Piacente are both concerned with decorative substrates useful as a flooring product and therefore are analogous.” However, in the June 6, 2011 Decision for *In re Arnold G. Klein* 2010-1411, the United States Court of Appeals for the Federal Circuit Court ruled that a determination that a prior art reference is analogous art presents an issue of fact and must be reviewed for substantial evidence. *In re Icon Health & Fitness, Inc.*, 496 F.3d 1374, 1378 (Fed. Cir. 2007). A reference qualifies as prior art for an obviousness determination under § 103 only when it is analogous to the claimed invention. *Innovation Toys, LLC, v. MGA Entertainment, Inc.*, No. 2010-1290, slip op. at 12 (Fed. Cir. Mar. 21, 2011); *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004); *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992). “Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *Bigio*, at 1325.

In this case, Piacente “require[s] a foamable layer, as in the case of the method aspects of a foamed layer, as in the case of the product aspects. The foamable compositions and layers of the present invention are characterized by an ability to produce, after appropriate foaming steps, a blown or foamed, cellular structure” (col. 3, lines 47-52). Piacente goes on to describe

the foamable layers contemplated by its invention: “*the foamable layer of the present invention preferably comprises a foamable composition containing polyvinyl chloride (PVC) resin, and even more preferably a foamable PVC plastisol composition*” (col. 3, lines 55-59).

Thus, Piacente is not directed to a “*laminated floor board comprising at least one cellulose sheet,*” as recited, for example, in claim 13 and similarly in claims 17 and 21. Furthermore, the structures in Piacente, including foamable compositions and layers and PVC resin are not cellulose sheets, as claimed. Piacente, is not directed to laminate floor boards of the present invention nor is it directed to the laminate floor boards of Martensson and, hence, is therefore considered to be non-analogous art as related to Martensson and/or the present invention. The structures and processes for achieving the surface characteristics of the products in Piacente are not applicable to the laminates of Martensson, nor could the structures of Piacente be applied to Martensson without considerable and undue experimentation, if at all, particularly in the context of a thermosetting laminate structure of Martensson. Hence, as was ruled in *In re Arnold G. Klein*, the prior art relied upon by the Examiner in the outstanding Office Action is non-analogous art, because it is not reasonably pertinent to the problem that the present invention addresses and, therefore, lacks substantial evidence for being considered as analogous art.

The Examiner states, on page 2 of the outstanding Office Action, that “*Piacente is not relied upon for teaching a printed pattern on a cellulose sheet. Piacente is relied upon for the teaching of a surface texture in register with, or that various in accordance with, a visual pattern printed on a substrate.*” However, Applicant respectfully asserts that one of ordinary skill in the art would **not** modify Martensson to provide a visual pattern, since doing so would change the principle operation of Martensson, thereby rendering Martensson unsatisfactory for its intended purpose. As directed by MPEP 2143.01(V), “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).” Moreover, as directed by the M.P.E.P. § 2143.01(VI), “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” Thus,

Applicant respectfully asserts that modifying Martensson with the alleged teachings of Piacente is not sufficient to render Applicant's claimed invention *prima facie* obvious.

Furthermore, the purported prior art combination fails to teach or fairly suggest, *inter alia*, "the perimeter area having an edge contour and interior region," as recited in claim 13 and similarly in claims 17 and 21. Applicants specification defines that avoiding the pressure from contact by users at the relieved perimeter area results in the improved wear resistance of the invention. Notably, paragraphs [0006]-[0007] of corresponding U.S. Patent Application Publication No. US 2004/0144051 A1 describe that one issue with the prior art is poor wear resistance because users' shoe soles contact both the center of a tile and the perimeter edge. Specifically, it explains that the perimeter edge is generally the weakest area so contacting the edge will cause that area to deteriorate first. The present invention address the aforementioned concerns by allowing the interior region to preferably bear most of the pressure, for example, from the user's shoes. If, for example, the interior region only has a small intermittent portions protruding above the perimeter area, the perimeter area would received the same or more pressure from the user's shoes. Thus, an important aspect of the claimed invention includes that the perimeter area is relieved below a portion of the interior region as claimed.

At best, Martensson merely discloses chamfering an edge of a board (*e.g.*, see FIG. 2, Col. 1, lines 33-34, and Col. 2, lines 31-36 of Martensson). Martensson, however, is silent with regards to providing any disclosure of the perimeter area as claimed. Again, Piacente fails to cure the deficiencies of Martensson, for example, by disclosing a relieved perimeter area as claimed by the present invention.

In accordance with the M.P.E.P. § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 196 (CCPA 1970). Therefore, it is respectfully submitted that neither Martensson nor Piacente, taken alone or in any proper combination, discloses or suggests the subject matter as recited in claims 13, 17, and 21.

Hence, withdrawal of the rejection is respectfully requested.

Each of the dependent claims depend from one of independent claims 13, 17, or 21 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claims 13, 17, and 21. In addition, each of the dependent claims also recites combinations that are separately patentable.

In view of the foregoing remarks, the claims are not rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

In view of the insufficiency of the present rejection, the next Office Action in the present application should set forth a prima facie case of unpatentability or allow the claims. If the next Office Action presents a rejection of any claim, such Office Action should be Non-Final to afford the Applicants a fair opportunity to address such rejection.

In discussing the specification, claims, and drawings in this response, it is to be understood that Applicant in no way intends to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 22-0259. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned patent attorney at (202) 312-3366.

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